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FACSIMILE COVER SHEET

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): COHEN-SOLAL, ERIC

Application No.: 09/738,650

Filing Date: 12/15/2000

Title: PICTURE-IN-PICTURE ...

Examiner: YENKE, Brian P.

Art Unit: 2614

Docket No.: US000395

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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being transmitted via facsimile No. **(571) 273-8300**, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 19, 2006.

Signature : 
Name : YURI KATESHOV

Transmitted herewith:

Amendments 4
Notice of Appeal (1)
Transmittal Letter (1)

Yuri Kateshov, Esq.
Date: January 19, 2006
Enclosures: (as listed above)

Total No. of pages, including this sheet: 7

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AMENDMENT TRANSMITTAL LETTER (Large Entity)

Applicants:
Cohen-Solal Eric

Docket No.
US000395

Application No.	Filing Date	Examiner	Group Art Unit
09/738,650	12/15/2000	Yenke, Brian P	2614

COMMISSIONER FOR PATENTS

Transmitted herewith is a pre-appeal request along with Notice of Appeal.

No additional fee is require for this amendment

Yuri Kateshov, Reg. No. 34,466
Dated: January 19, 2006

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By _____
Yuri Kateshov (Signature)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	COHEN-SOLAL, Eric
Serial No.	:	09/738,650
Filed	:	December 15, 2000
Atty. Docket	:	US000395
Group Art Unit	:	2614
Examiner	:	Yenke, Brian P.
Conf. No.	:	1565

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed November 22, 2005, please consider the remarks that follow. Please note that a Notice of Appeal with the requisite fee was mailed in this case on July 15, 2005. A new Notice of Appeal pursuant to 37 CFR 41.31 (MPEP 1204.01) is enclosed herewith. However, no fee is due with the Notice of Appeal filed concurrently herewith as the undersigned requests that the fee previously paid under 37 CFR 41.20 be applied to the reinstatement of the appeal.

REMARKS

Claims 1, 3, 6-8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by the alleged Applicant's Admitted Prior Art (hereinafter "Applicant's spec"). Claims 4, 5 and 10 are rejected under 35 U.S.C. 103 as being obvious over Applicant's spec. Claim 9 is rejected under 35 USC 103 as being obvious over Applicant's spec in view of U.S. Patent Application Publication No. 2002/0069411 (hereinafter "Rainville"). Applicant respectfully submits that there are clear factual errors in the rejections. Applicant further submits that a prima facie case of anticipation or obviousness has not been established to sustain the rejections on legal ground as well.

Independent claim 1 requires, among other things, that the processor change a PIP display characteristic in response to the determination that at least one characteristic is present in the primary image, the primary image characteristic being at least one of a continuous color portion and a continuous texture portion.

In the Final Office Action, it is alleged that Applicant's single statement in the specification is prior art and it anticipates the above limitation in Applicant's claim 1. This sentence is reproduced hereinbelow as follows:

> In other systems, the PIP may be automatically repositioned to a portion of the primary display in response to detected motion between one frame of the video image and the next frame.

It appears that the Examiner draws the following conclusion from Applicant's sentence: "[s]ince prior art systems reposition the PIP in response to the detected motion, the limitation of a continuous color portion being determined is met, **since the discontinuity of a color (brightness, contrast) portion is what determines when there is motion or not/scene**

change" (Final Office Action, page 3; emphasis added). The Examiner is wrong factually and legally.

The Examiner's conclusory statement on the discontinuity of color resulting in a motion/scene change is not supported by the record. The Examiner has not provided any personal affidavit stating such personal knowledge. The Examiner has not provided any prior art references to that fact. The Examiner has not provided any affidavits from a skilled artisan to that fact. Clearly, it is a conclusory statement that has no factual basis in the record.

The Examiner's conclusory statement is also incorrect from a legal standpoint. Nowhere does Applicant state that his statement "the PIP may be automatically repositioned to a portion of the primary display in response to detected motion between one frame of the video image and the next frame" refers to a prior art system. It is respectfully submitted that the description in the background of the invention is not prior art unless Applicant explicitly admits so. It appears that the Examiner has imputed the prior art status to Applicant's entire background of the invention section. It is impermissible under case law.

For the above reasons, it is respectfully submitted that the rejection of Applicant's claim 1 is clearly erroneous in fact and in law.

The remaining claims, claims 3-11 all depend from independent claim 1 and thus incorporate novel and nonobvious features thereof. Accordingly, claims 3-11 are patentably distinguishable over Applicant's spec for at least the reasons that independent claim 1 is patentably distinguishable. Therefore, the rejections of the claims are improper.

It is noteworthy that according to the November 22nd Final Office Action, "based upon Applicant's Appeal Brief and upon further review/consideration the examiner has withdrawn the previous rejection." The new final rejection, however, relies on the same alleged AARP in rejecting claims 1 and 3-11 as in the previous final rejection. The undersigned cannot discern the

Examiner's intention in such a maneuver, but it appears to run contrary to the USPTO policy on advancing the prosecution of a patent application to its final resolution, wastes Applicant's resources, and forces Applicant to incur unnecessary costs. If such Examiner's action were in a court of law, he would certainly be subject to court costs and attorney's fees.

Based on the arguments set forth herein, it is respectfully submitted that the rejections of Applicant's claims on appeal in the application should be reversed and allowed to issue in expeditious manner.

Respectfully submitted,

By _____
Yuri Kateshov, Reg. No. 34,466
914-723-6802